

### **REMARKS/ARGUMENTS**

On pages 2 and 3 of the Office action, claims 3, 6, 7, 10, 11 and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,447,272 issued to Tsuchiya in view of U.S. Patent No. 2,594,555 in view of Hardy.

Claim 3 of the present application calls for:

An external rotor motor with a stator (11) and a rotor (13), which surrounds the stator (11) while leaving an air gap (14), wherein at least one damper (16) that is composed at least partially of an elastic material is arranged on the outside of the rotor (13), characterized in that the rotor (13) is pot-shaped with a pot base (131) and pot jacket (132) and that the damper (16) comprises a damper cap (17), which surrounds the pot jacket (132) or at least partially covers the pot base (131).

Also, claim 6 of the present application calls for:

An external rotor motor with a stator (11) and a rotor (13), which surrounds the stator (11) while leaving an air gap (14), wherein at least one damper (16) that is composed at least partially of an elastic material is arranged on the outside of the rotor (13), characterized in that an assembly (26) with a hub (22) driven by the rotor (13) is slid over the damper (16) and non-rotatably connected to the rotor (13).

In contrast, Tsuchiya only discloses a ventilating fan driven by an external rotor motor, and provides no teaching or suggestion regarding vibrational damping, while Hardy deals with isolation of a belt pulley driven by the drive shaft of an internal combustion engine.

The Applicant respectfully submits that no connection between Tsuchiya and Hardy exists that justifies an obviousness finding of claims 3 and 6. As will now be discussed in greater detail, the Applicant respectfully submits that the combination of Tsuchiya and Hardy is retrospective, results from impermissible hindsight reconstruction, and is based upon knowledge of the rotor claimed in claims 3 and 6.

No indication exists in Tsuchiya, Hardy, or their combined teachings to integrate the disclosure of one document into the device of the other. However, even if such an indication did

exist (and the Applicant respectfully submits that it does not), the combined teachings of Tsuchiya and Hardy would not lead to the apparatus claimed in claims 3 and 6.

The damping mechanism 19 (or 119, 219, 319) of the Hardy devices have no damper caps whatsoever. In this regard, if one skilled in the art were motivated to combine a damping element from Hardy with a motor disclosed by Tsuchiya (and again, such a motivation can be found nowhere in either reference), the resulting damping element would be attached on both the inner and outer sides of the rotor bell 11 in the Tsuchiya device. However, such a structure is impermissible based upon the teachings of Tsuchiya. Specifically, the permanent magnets 14 of the Tsuchiya device would no longer be fixed on the rotor bell 11 as taught by Tsuchiya. Instead, a vibration-dampening element would be attached between the rotor bell 11 and the permanent magnets 14. However, no such suggestion exists to make this further modification to the Tsuchiya device without impermissible hindsight reconstruction.

In addition, the electric motor of the Tsuchiya device fails to disclose any clearance between the outer side of the rotor bell 11 and the cylindrical body 9 of the fan wheel 8 sufficient to enable an elastic element 19 (or 119, 219, 319) as disclosed by Hardy to be integrated into the Tsuchiya device. Once again, to further modify the Tsuchiya device in order to enable this integration requires impermissible hindsight reconstruction.

There is clear U.S. established case law setting forth what can be considered "obvious" in light of a combination of documents (e.g., *In re Rijckaert* 9 F3d 1531, 1532, 28 USPQ 2d 1955, 1956 (Fed. Cir. 1993). A complete reconstruction of a device in order to arrive at a conclusion of obviousness is not reasonable. In the present rejection, Tsuchiya's ventilating fan would have to be completely reconstructed to incorporate a damping element (from the teachings of Hardy) into the Tsuchiya ventilating fan – all without any motivation regarding why such a change would be necessary or desirable. Also, the Applicant respectfully submits that a person skilled in the art receives no inspiration or motivation to make such changes to the Tsuchiya fan based upon the teachings or either document.

Accordingly, the Applicant respectfully submits that claims 3 and 6 are allowable over Tsuchiya, Hardy, and their combined teachings. Withdrawal of the 35 U.S.C. §103(a) rejections of claims 3 and 6 is therefore requested.

Claims 7, 10, 11, and 22 are each dependent upon one of claims 3 and 6, and are allowable based upon claims 3 and 6 and upon additional features and elements claimed in claims 7, 10, 11, and 22 but not discussed herein. Withdrawal of the 35 U.S.C. §103(a) rejections of claims 7, 10, 11, and 22 is therefore requested.

If any issues remain outstanding upon entry of this Amendment, the Examiner is respectfully requested to telephone the undersigned Applicant's Representative at (414) 225-8266.

Respectfully submitted,



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